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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,636	03/24/2004	Brandon Crabtree	P314760	6089
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HUGHES LAW FIRM, PLLC PACIFIC MERIDIAN PLAZA, SUITE 302 4164 MERIDIAN STREET BELLINGHAM, WA 98226-5583			EXAMINER BRAHAN, THOMAS J	
			ART UNIT	PAPER NUMBER
			3654	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,636

Applicant(s)

CRABTREE, BRANDON

Examiner

Thomas J. Brahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 15-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/24/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Restriction between the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to a hoisting assembly, classified in class 254, subclass ----.
 - II. Claims 15-19, drawn to a method of removing a differential, classified in class 29, subclass 426.1.
 - III. Claims 20-29, drawn to a method of attaching a differential, classified in class 29, subclass 428.
2. The inventions are distinct, each from the other because of the following reasons:
 - Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus can be used to practice another and materially differently process such as lifting building components (i.e. beams).
 - Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus can be used to practice another and materially different process such as lifting building components (i.e. beams).
 - Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions because Invention Group II is directed to a process of removing a differential and Invention Group III is directed to a process of assembling a differential.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Examiner Jermie Cozart on January 10, 2006, Mike Hughes made a provisional election without traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. The following is a quotation of the all of the paragraphs of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.

A claim may be written in independent or if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim

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previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

6. Claims 2-7 are rejected under 35 U.S.C. § 112, second and fourth paragraphs, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (35 U.S.C. § 112, second paragraph) and failing to specify a further limitation of the subject matter claimed (35 U.S.C. § 112, fourth paragraph).

a. It is unclear as to how claim 2 particularly points out and distinctly claims the subject matter of the invention and further limits the invention of claim 1. The first limitation of claim 2, "where the vehicle has a longitudinal axis indicating a longitudinal direction" refers to the vehicle which is not part of the claimed invention, the claimed invention is a hoist for use on a vehicle frame. This limitation is useful in defining a direction as the longitudinal direction, but it does not set forth any structure. The remaining limitation in claim 2 recites an "adapted to" limitation for the central frame of the hoist. Such recitations that an element is "adapted to" perform a function is not a positive limitation and only requires the ability to so perform, in re Hutchinson 69 USPQ 138. The second limitation of the claim only recites an ability or characteristic of the central frame, it does not recite any structural limitations for the central frame. The central frame limitation also appears to incomplete and confusing. It states that the "central frame is adapted to reposition in the longitudinal direction". The grammar in this limitation is awkward and could be interpreted as meaning the frame itself is "adapted to be repositioned" or that the frame repositions another element.

b. It is unclear as to how claim 3 particularly points out and distinctly claims the subject matter of the invention and further limits the invention of claim 1, as it is entirely drawn to an "adapted to" phrase as to recite a function or intended use of the hoist elements without reciting a structural limitation as further limit the claimed invention.

c. Claim 4 is states a position of the differential, i.e. the object being lifting without including a limitation drawn to the structure of the claimed invention.

d. Claims 5 and 6 recite an intended use of the hoisting device without correlating it to any structure of the invention. The intended use is also unclear, as the limitation "can reposition laterally" does not specify what is being repositioned laterally.

e. Claim 7 is drawn to an "adapted to" limitation and fails to include any additional limitations drawn to structural features.

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7. Claims 13 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to how applicant is considering the device as having two containment brackets which both extend around outward surfaces of the frame member of a vehicle. Each bracket appears to extend about a different frame member, not the same frame member. It also appears that each bracket extends around one outward surface of its frame member, not plural outward surfaces.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 and 7, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Vernor. Vernor shows a hoisting assembly for supporting a differential (18) of a vehicle having a frame, the vehicle having a differential (18) that is adapted to be attached to an axle (14/15) of the vehicle, the hoisting assembly comprising:

a central frame (25) having first and second lateral ends and a central area;

a hoisting device (28) adapted to be mounted to the central area of the central frame, the hoisting device comprising an attachment member (29) that is adapted to be mechanically attached to the differential of the vehicle;

whereas, the hoisting device is adapted to raise the attachment member vertically and the article attached thereto and support the article where the central frame is positioned substantially vertically above the article and the hoisting assembly is adapted to be mounted to the frame of the vehicle.

As the hoisting device is just placed on the vehicle frame, the device is readily repositioned, longitudinally or laterally with respect to the vehicle frame, as recited in claim 2. The hoisting device has a flexible chain which can inherently be moved to lift a load not directly under the hoisting device, as recited in claims 3 and 4. The attachment member (29) engages recessed region of the differential, as recited in claim 7.

11. Claims 1-8, 10 and 13, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Faulk. Faulk shows a hoisting assembly for supporting an article of a vehicle having a frame, the hoisting assembly comprising:

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a central frame (25-27) having first and second lateral ends and a central area;

a hoisting device (28) adapted to be mounted to the central area of the central frame, the hoisting device comprising an attachment member (43) that is adapted to be mechanically attached to the article of the vehicle;

whereas, the hoisting device is adapted to raise the attachment member vertically and the article attached thereto and support the article where the central frame is positioned substantially vertically above the article and the hoisting assembly is adapted to be mounted to the frame of the vehicle.

The article intended to be lifted, a differential, is not given any patentable weight, as the hoisting assembly of Faulk has all the structural limitations recited in the claims and could be used to lift a differential instead of a transmission. The central frame (25-27) is mounted to pivot about axis (19) as to be repositioned in the longitudinal direction of the vehicle frame, as recited in claim 2; note also that the entire hoist can be repositioned along the frame by loosening clamps (9). The attachment member (43) is a flexible chain which can inherently be moved to lift a load not directly under the hoisting device, as recited in claims 3 and 4, and can engage a recessed region of the load, as recited in claim 7. The hoisting device (28) moves laterally on the central frame, see page 2, line 11, as recited in claims 5 and 6. The central frame has first and second longitudinal members that are in elements at the ends (such as screws 8, braces 11, rods 17 or pins 23), as the term longitudinally does not have to be considered as the longitudinal direction of the travel of the vehicle, as recited in claims 8 and 10. Faulk has containment brackets (15/16) which engage the outside of frames (11) of the vehicle, as claim 13 is best understood.

12. Claims 1, 3-7 and 13, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Hardin. Hardin shows a hoisting assembly for supporting a differential (15) of a vehicle having a frame, the vehicle having a differential (15) that is adapted to be attached to an axle (14) of the vehicle, the hoisting assembly comprising:

a central frame (60/62) having first and second lateral ends and a central area;

a hoisting device (65) adapted to be mounted to the central area of the central frame, the hoisting device comprising an attachment member (96) that is adapted to be mechanically attached to the differential of the vehicle;

whereas, the hoisting device is adapted to raise the attachment member vertically and the article attached thereto and support the article where the central frame is positioned substantially vertically above the article and the hoisting assembly is adapted to be mounted to the frame of the vehicle.

The hoisting device has a flexible chain which can inherently be moved to lift a load not directly under the hoisting device, as recited in claims 3 and 4. The hoisting device (65) is mounted with a roller (72) as to be moved laterally on the central frame, if laterally is considered as from right to left as viewed in figure 2, as recited in claims 5 and 6. The attachment member engages a recessed portion on the differential, as recited in claim 7. Hardin has four containment brackets (25) as to have first and second containment brackets at lateral ends, regardless of which direction is considered as the lateral direction, which extend around the vehicle frame members to mount and position the hoisting assembly, indirectly, as recited in claim 13.

Note that Hardin teaches that a transmission hoist can be used to lift a differential, see the second paragraph

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of page one.

13. Claims 1-4, 7, 9, 11, 13 and 14, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Sanderson. Sanderson shows a hoisting assembly comprising:

a central frame (5) having first and second lateral ends and a central area;

a hoisting device (15) adapted to be mounted to the central area of the central frame, the hoisting device comprising an attachment member (21).

The hoisting device attachment member is considered as "adapted to" be attached to a differential and the hoisting device is considered as adapted to raise a differential, as it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation and only requires the ability to so perform, in re Hutchinson 69 USPQ 138. The central frame (5) pivots as to be repositioned longitudinally of the vehicle, as recited in claim 2. The hoisting device can be "adapted to" lift a load not directly under the hoisting device, as recited in claims 3 and 4, and "adapted to" lift a differential at a recessed portion, as recited in claim 7. The hoisting device has a cable (17), as recited in claim 9, and a crank member (25), as recited in claim 11. The hoisting device includes first and second containment brackets (9) at the lateral ends of the central frame (5) that extend vertically downwardly and around outward surfaces of the frame members of the vehicle, as claims 13 and 14 are best understood.

14. Claims 1-4, 7, 9 and 11, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Berggren. Berggren shows a hoisting assembly for supporting an article of a vehicle having a frame, the hoisting assembly comprising a central frame (6) having first and second lateral ends and a central area, a hoisting device (10) adapted to be mounted to the central area of the central frame, the hoisting device comprising an attachment member (5) that is adapted to be mechanically attached to the article of the vehicle. The article intended to be lifted, a differential, is not given any patentable weight, as the hoisting assembly of Berggren has all the structural limitations recited in the claims and could be used to lift a differential instead of a transmission. The hoisting device is placed on the vehicle frame and can be repositioned longitudinally, as recited in claim 2. The flexible cable (19) can inherently be moved to lift a load not directly under the hoisting device, as recited in claims 3 and 4. The attachment member engages a recessed region of the load, as recited in claim 7. The hoisting device has a cable (19), as recited in claim 9, and a crank (14) as recited in claim 11.

15. Claims 1-4, 7, 9-14, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Fow. Fow shows a hoisting assembly for supporting an article of a vehicle having a frame, the hoisting assembly comprising a central frame (10/11) having first and second lateral ends and a central area, a hoisting device (20) adapted to be mounted to the central area of the central frame, the hoisting device comprising an attachment member (hook) that is adapted to be mechanically attached to the article of the vehicle. The article intended to be lifted, a differential, is not given any patentable weight, as the hoisting assembly of Fow has all the structural limitations


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recited in the claims and could be used to lift a differential as it lifts a transmission and related drive train elements. The hoisting device is placed on the vehicle frame and can be repositioned longitudinally, as recited in claim 2. The flexible cable (18) can inherently be moved to lift a load not directly under the hoisting device, as recited in claims 3 and 4. The attachment member can engage a recessed region of the load, as recited in claim 7. The hoisting device has a cable (18), as recited in claim 9, and a crank (22) as recited in claim 11. The frame includes longitudinally extending members (15) in the ends, as recited in claims 10 and 12. Containment brackets (14 and 16) extend around lateral sides of frame members (13) of the vehicle that are outwards with respect to the frame member(s), as claims 13 and 14 are best understood, alternatively, see the next rejection.

16. Claims 13 and 14, as best understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fow in view of Shirley or Denny. Fow shows the basic claimed hoisting device that can be adapted to lift drive train devices, but varies from the claims, depending upon claim limitation interpretation, by not having the containment brackets extending along the outer surfaces of the frame members of the vehicle. Shirley shows a similar lift tool that uses hooks or chains to attachment to the vehicle frame. Denny shows a similar mounting with brackets (8/9) engaging the upper and the outer surfaces of an inverted C-shaped frame member. It would have been obvious to one of ordinary skill in the art at the time the invention was made by applicant to modify the lifting device of Fow by substituting hooks or brackets that engage the outer surfaces of the vehicle frame members, for the clamps (16), for use with vehicle frames which do not include C-shaped beams which can be clamped from the sides, as taught by Shirley or as taught by Denny.

17. Armstrong, Dice, Haley and Brooks are cited as showing related hoists.

18. An inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Brahan whose telephone number is (571) 272-6921. The examiner's supervisor, Ms. Katherine Matecki, can be reached at (571) 272-6951. The new fax number for all patent applications is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Questions regarding access to the Private PAIR system, should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Thomas J. Brahan
Primary Examiner
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